

26. The method of claim 1, further comprising:
determining the recording reminder time based on the received user input, with the
recording reminder time preceding the recording time for the scheduled recording
by an amount of time based on the received user input.

REMARKS

As a result of this amendment, claim 1 has been amended, and claims 1, 2, 4-13, 15-17, 20, 21, 24, and 26 are still pending in this application.

Applicant reserves the right to address any express or tacit characterization of the cited references to the extent the following remarks do not.

Response to §102 Rejections

Claims 1-2, 8-11, 13, 17, 21, 24 and 26 were rejected under 35 USC § 102(b) as anticipated by Young (U.S. Patent 4,706,121). Applicant traverses this rejection as follows.

Claim 1, as amended, recites “receiving user input at least partially determinative of a recording reminder time for the scheduled data recording, with the user input being non-determinative of the recording time.”

In contrast, Young reports a system that receives user input for programming the time of a recording and issues a warning five minutes before the programmed time of the recording. Young states, at column 20, lines 50-53, “[i]f the TV 126 is not on at 502, the alarm 156 will be sounded five minutes before the start of the scheduled program.” Young does not appear to take any other user input regarding the warning period. Thus, it appears that the user input for programming the recording time is determinative of not only when the recording occurs but also when the warning occurs. Therefore, Young does not teach receiving user input that is “partially determinative of a recording reminder time” and “non-determinative of the recording time,” as recited in claim 1 and claims 2, 8-10, and 26 depending therefrom.

Claim 26 further recites “determining the recording reminder time ... preceding the

recording time for the scheduled recording by an amount of time based on the received user input.”

In contrast, Young only mentions sounding a fixed, five-minute warning before a scheduled recording. The five-minute period preceding the scheduled recording is not based on any received user input. In the Action (at first paragraph on page 6), the Examiner suggests that user input to schedule or program a recording affects an amount of time the system in Young must monitor before it sounds its alarm. This monitoring time is the time between when the user acts to schedule the recording and when the alarm is sounded. However, claim 26 requires that the amount of time between output of the reminder (for example, sounding an alarm) and the scheduled time of the recording be based on the user input, not the monitoring time prior to output of the reminder. Therefore, claim 26 distinguishes over Young for this additional reason.

Accordingly, applicant respectfully requests that the Examiner reconsider and withdraw the § 102 rejection of claims 1, 2, 8-10, and 26.

Claim 11 recites “means for scheduling the recording device to begin automatic recording of the one program at a recording time,” “means for receiving user input regarding a recording reminder,” and “means for determining a recording reminder time for at least the one program based on the recording time and the user input regarding the recording reminder.”

In contrast, the only user input that Young appears to use in determining its five-minute warning is the user input for scheduling a recording, that is, setting the recording time. There is no indication in Young that the time for issuing the five-minute warning is based on both a recording time and user input regarding a recording reminder. Instead, the five-minute warning in Young is fixed.

Accordingly, applicant respectfully requests that the Examiner reconsider and withdraw the § 102 rejection of claim 11 and dependent claim 13 based on Young.

Claim 17 recites “receiving user input at least partially determinative of a recording reminder time ... preceding a time of the scheduled automatic data recording by an amount of time based on the user input” and “outputting a reminder signal at the recording reminder time

before initiation of the scheduled automatic data recording.” Claim 21 recites “receiving user input at least partially determinative of a recording reminder time ...preceding the future time [of the scheduled recording] by an amount of time based on the user input.” Claim 24 recites “receiving two or more user remind-time inputs” and “defining two or more recording reminder times ... with each ... preceding a respective time for initiation of its associated scheduled recording by amounts of time based on the respective remind-time inputs.”

On the other hand, Young reports sounding a fixed, five-minute warning before a scheduled recording. There is no mention of receiving any user input to change or otherwise affect this fixed time period for the warning.

Accordingly, applicant respectfully requests that the Examiner reconsider and withdraw the § 102 rejection of claims 17, 21, and 24.

Response to §103 Rejections

Claims 4-6, 12 and 15 were rejected under 35 USC § 103(a) as unpatentable over Young in view of Hoff (U.S. Patent 5,467,197).

In response, applicant submits that claims 4-6, 12, and 15 stem from independent claim 1 or 11, both of which distinguish from Young as highlighted above. Moreover, it does not appear, even if Hoff were properly combinable with Young, that Hoff overcomes the deficiencies of Young relative to claims 1 and 11.

Specifically, Hoff fails to teach or suggest “receiving user input at least partially determinative of a recording reminder time for the scheduled data recording, with the user input being non-determinative of the recording time,” as claim 1 requires. Hoff also fails to teach “means for determining a recording reminder time for at least the one program based on the recording time and the user input regarding the recording reminder,” as claim 11 requires. Indeed, there is no occurrence of “remind” or “reminder” in the entire text of Hoff. Thus, Hoff does not overcome the deficiencies of Young.

Additionally, applicant submits that the § 103 rejection as set forth in the Action fails to establish a *prima facie* case of obviousness for want of a proper motivation for combining Young and Hoff. In particular, the Examiner asserts that one of ordinary skill would combine Hoff’s

teachings regarding network communications devices with Young's teaching to increase the dynamic range of Young. Yet, there is no apparent evidence in either Young or Hoff that Young suffers from an insufficient "dynamic range" in outputting its five-minute warning alarm or that Hoff increases "dynamic range" by outputting an alarm through a network communications device. Indeed, the text of the rejection is devoid of any citation associating dynamic range issues with output of an alarm. Thus, the asserted "dynamic range" motivation appears insufficient to sustain the combination.

Similarly, the motivation asserted regarding claim 5 also appears insufficient. Specifically, the text of the rejection asserts that one would modify Young to output its five-minute warning to a pager "in order to output to a pager." However, this motivation is unsubstantiated in the cited art, and thus appears to be based on an impermissible degree of hindsight.

Accordingly, applicant respectfully requests that the Examiner reconsider and withdraw the § 103 rejection of claims 4-6, 12 and 15 based on Young and Hoff.

Claims 7, 16 and 20 were rejected under 35 USC § 103(a) as unpatentable over Young in view of Strubbe (U.S. Patent 5,047,867).

In response, applicant submits that claims 7, 16, and 20 stem from independent claim 1, 11, or 17, all of which distinguish from Young as highlighted above. Moreover, it does not appear, even if Strubbe were properly combinable with Young, that Strubbe overcomes the deficiencies of Young relative to claims 1, 11, and 17.

Strubbe does not teach or suggest "receiving user input at least partially determinative of a recording reminder time for the scheduled data recording, with the user input being non-determinative of the recording time," as claim 1 requires. Strubbe also fails to teach or suggest "means for determining a recording reminder time for at least the one program based on the recording time and the user input regarding the recording reminder," as claim 11 requires. And, Strubbe fails to teach or suggest "receiving user input at least partially determinative of a recording reminder time ... preceding a time of the scheduled automatic data recording by an amount of time based on the user input," as claim 17 requires.

In contrast, Strubbe (as detailed previously in the response to the Office Action dated August 19, 1999) appears only to report options for a user to toggle a recording reminder function on or off and to select the type of reminder; it lacks an option to define, either in whole or in part, the timing of the reminder relative to a scheduled recording. Thus, even if it were permissible to combine Young and Strubbe as the Action suggests, it would not overcome the deficiencies of Young.

Additionally, applicant submits that this § 103 rejection as set forth in the Action fails, pursuant to MPEP 2143.01, to establish a prima facie case of obviousness for want of a proper motivation for combining Young and Strubbe. In particular, the Examiner asserts that one of ordinary skill would combine Strubbe's "teachings" regarding a recording-media message with Young to make Young's five-minute alarm "more complete and easily understandable." However, there is no apparent evidence in either Young or Strubbe that Young's five-minute alarm is incomplete or incomprehensible.

Moreover, even if there were a statement in a reference that the alarm was both incomplete or incomprehensible, such a statement alone would not lead one of ordinary skill to conclude that recording-media content was necessary to make Young's alarm complete and comprehensible. Indeed, a general motivation for completeness and comprehensibility may be argued to surround any communications, but such a motivation, absent hindsight, would not move one of ordinary skill in any particular direction relative to Young. Thus, the asserted motivation appears insufficient to sustain the combination.

Accordingly, applicant respectfully requests that the Examiner reconsider and withdraw the § 103 rejection of claims 7, 16 and 20 based on Young and Strubbe.

Conclusion

In view of the amended claims and foregoing remarks, applicant respectfully requests reconsideration of the application. Moreover, applicant invites the Examiner to call its patent counsel Eduardo Drake (612-349-9593) to address any issues that may impede allowance.

AMENDMENT AND RESPONSE UNDER 37 CFR § 1.111

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Respectfully submitted,

THEODORE D. WUGOFSKI

By their Representatives,

SCHWEGMAN, LUNDBERG, WOESSNER & KLUTH, P.A.
P.O. Box 2938
Minneapolis, MN 55402
(612) 349-9593

Date

7 Aug. 2001

By

Eduardo H. Drake
Reg. No. 40,594

CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: Commissioner of Patents, Washington, D.C. 20231, on this

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Candis B. Buending

Name

Candis B. Buending
Signature